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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,053	02/17/2004	Nosa Omoigui	NERV-1-1006	8380

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Richard T. Black, Esq.
BLACK LOWE & GRAHAM PLLC
Suite 4800
701 Fifth Avenue
Seattle, WA 98104

EXAMINER

LE, MICHAEL

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/781,053

Applicant(s)

OMOIGUI, NOSA

Examiner

Michael Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/20/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Drawings***

1. The drawings are objected to because the drawings contain screen shots that are not of a quality that can be clearly understood. The text contained within the screenshots can not be read and the actual images themselves are of a shading that would not allow them to be reproduced indefinitely without loss of quality. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The use of the trademarks has been noted in this application. Some examples are Google and Lexis in page 10, line 5; Reuters throughout the specification; Intel in page 37, lines 15-16; J2EE in page 39, line 12; Outlook and Exchange, in page 41, line 37; and NT and Active Directory in page 48, line 22. Trademarks should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Some examples are in page 48, lines 26-27; page 54, line 4; and page 149, lines 9-10. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

4. Claim 1 is objected to because of the following informalities:
5. Line 7, recites "semantic ascertaining", which is grammatically incorrect.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 2 recites the limitation "the first server" in line 1. There is insufficient antecedent basis for this limitation in the claim.

9. The term "semantically" in claim 3, line 4 and claim 4, lines 5, 6 is a relative term which renders the claim indefinite. The term "semantically" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term needs to be defined in the specification. A definition of the term in the specification would not be considered new matter, as it is for further clarification.

10. The prior art rejections for claims 1-4 below are made as best understood in light of the 35 U.S.C. 112, second paragraph rejections as addressed above.

Claim Rejections - 35 USC § 101

11. 35.U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- Claim 4 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological art fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In *Bowman* (Ex parte *Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although *Bowman* discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

In the present case, claim 4 recites an abstract idea (e.g. an algorithm or a design) at the preamble; in addition, the steps in the claim body merely recite steps in retrieving information from a source, organizing the information, delivering the information

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according to a request from a person and presenting it to the person according to their preferences. These steps can be implemented by the mind of a person or by the use of a pencil and paper, in other words the method claimed can be written down and performed step by step to obtain the same result. Since the claimed invention, as a whole, is not within the technological arts as explained above, these claims only constitute an idea and does not apply, involve, use, or advance the technological arts, thus, it is deemed to be directed to non-statutory subject matter.

To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Presnell et al. (US Patent 6,182,067).

14. In regards to claim 1, Presnell discloses a system for knowledge retrieval, management, delivery and presentation comprising:

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- a. a server programmable to maintain semantic information (Fig. 1, 4; col. 7, lines 22-31, 44-52; col. 8, lines 5-47)¹;
 - b. a client providing a user interface for a user to communicate with the server (Fig. 1; col. 7, lines 32-40); and
 - c. wherein the processor of the server operates to perform the steps of:
 - i. securing information from information sources (Col. 12, lines 20-28, 35-38; col. 13, lines 40-46)²;
 - ii. semantic ascertaining one or more semantic properties of the information (Fig. 4; col. 8, lines 5-47)³; and
 - iii. responding to user queries based upon one or more of the semantic properties (Fig. 16; col. 16, lines 54-62)⁴.
15. In regards to claim 2, Presnell discloses the system of claim 1, wherein the first server further comprises structure or methodology directed to providing at least one of the following: a Semantic Network, a Semantic Data Gatherer, a Semantic Network Consistency Checker, an Inference Engine, a Semantic Query Processor, a Natural Language Parser, an Email Knowledge Agent, or a Knowledge Domain Manager (Col. 7, lines 22-31, 44-52; col. 1, lines 20-28)⁵.

¹ As can be seen in figure 1, there is a knowledge server. The knowledge server can be programmed with software modules that perform certain functions, such as those functions described in the profiling phase and depicted in figure 4. The knowledge server could be programmed to add concepts (semantic information) and modify (maintain) them when necessary.

² Extracting phase of the knowledge system is gathering information from different sources including the internet and other electronic databases (securing information from an information source).

³ The knowledge server could be programmed to process (ascertain) the concepts (semantic properties of the information) and modify (maintain) them when necessary as shown in figure 4.

⁴ The system takes the information and delivers to the users that nominate interest (user query).

⁵ The knowledge server has the ability to be programmed (comprises the methodology) to extract information from information sources (directed to providing a Semantic Data Gatherer).

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16. In regards to claim 3, Presnell discloses the system of claim 1, wherein:
- a. the information comprises objects (Col. 13, lines 10-17)⁶; and
 - b. the semantic properties of the objects or events are represented by active agents for semantically linking to the semantics and properties of the queries (Col. 13, lines 10-17; col. 18, lines 4-16)⁷.
17. In regards to claim 4, Presnell discloses a method for knowledge retrieval, management, delivery and presentation for use with a server system programmed to add, maintain and host domain specific information that is used to classify and categorize semantic information, comprising:
- a. securing information from information sources (Col. 12, lines 20-28, 35-38; col. 13, lines 40-46)⁸;
 - b. semantically linking the information from the information sources (Fig. 10; col. 13, lines 50-61)⁹;
 - c. maintaining the semantic attributes of the semantically linked information (Fig. 4; col. 8, lines 5-47)¹⁰;

⁶ In this example, the system extracts URLs (objects) from the Internet search engines (information sources).

⁷ The URLs (objects are agents) are semantically related because they were retrieved using a search that took into consideration concept names and terms (semantic information) of the user profiles. Since they were retrieved by a search (query) then they represent the query and when used, the URLs will return the web documents (return data objects) that will be presented to the user according to a profile (predetermined theme). In this given example, the URLs are agents because when activated, information is retrieved, which is the purpose of the agent. The concept can be expanded to other examples.

⁸ Extracting phase of the knowledge system is gathering information from different sources including the internet and other electronic databases (securing information from an information source).

⁹ The knowledge server can be programmed with software modules that perform certain functions, such as those functions described in the cataloguing phase and depicted in figure 10. The documents stored on the knowledge server contain concepts (domain-specific information) that are used to catalogue (semantically linking) the documents and concepts (semantic information).

¹⁰ The knowledge server could be programmed to add concepts (domain-specific semantic information) and modify (maintain) them when necessary as shown in figure 4.

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- d. delivering requested semantic information based upon user queries (Fig. 16; col. 16, lines 54-62)¹¹; and
- e. presenting semantic information according to customizable user preferences (Fig. 20; col. 18, lines 4-16)¹².

Double Patenting

18. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

19. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6, 13, 14, 34, 35, 48, 53, 91, 92, 93, 106, 107, 120, 121, 134 and 135 of copending Application No. 10/179651. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

¹¹ The system takes the information and delivers to the users that nominate interest (user query).

¹² The system displays the information according to the profiles and interests (customizable user preferences) of the user.

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20. Claim 1 of the present application is essentially claims 1, 13, 34, 53, 91, 92, 106, 120 and 134 of copending Application No. 10/179651 with the following differences:

21. Claim 1 of the present application is essentially claims 1, 53, 92, 106, 120 and 134 of copending Application No. 10/179651 with the difference of not claiming either a plurality of first servers, a plurality of second servers or a second server and replacing “processor of the server” with --the system--.

22. Claim 1 of the present application is essentially claims 13, 34, 53, and 91 of copending Application No. 10/179651 with the difference of not claiming “add” and “host domain-specific semantic information used to classify and categorize information” and replacing “processor of the server” with --the system--.

23. Therefore, the scope of claim 1 of the present invention is broader than the scope of claims 1, 13, 34, 53, 91, 92, 106, 120 and 134 of copending Application No.

10/179651. Furthermore, it is obvious to eliminate an element In Re Karlson, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963).

24. Claim 2 of the present invention is exactly the same as claim 2 of copending Application No. 10/179651.

25. Claim 3 of the present invention is essentially claims 3, 14, 35, 93, 107, 121 and 135 of copending Application No. 10/179651 with the following differences:

26. Claim 3 of the present invention is essentially claims 14, 35, 93, 107, 121 and 135 of copending Application No. 10/179651 with the difference of not claiming information

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from the information sources consisting of objects “or events” and “queries that return data objects for presentation according to a predetermined theme”.

27. Claim 3 of the present invention is essentially claim 3 of copending Application No. 10/179651 with the difference of not claiming “queries that return data objects for presentation according to a predetermined theme”.

28. Therefore, the scope of claim 3 of the present invention is broader than the scope of claims 3, 14, 35, 93, 107, 121 and 135 of copending Application No. 10/179651. The claims in both applications, the second limitation claims representing the objects or events as active agents that are semantically linked and used for queries. Furthermore, it is obvious to eliminate an element In Re Karlson, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963).

29. Claim 4 of the present invention is exactly the same as claim 6 of copending Application No. 10/179651.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

30. Claims 1-4 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3, 6, 13, 14, 34, 35, 48, 53, 91, 92, 93, 106, 107, 120, 121, 134 and 135 of copending Application No. 10/179651. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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31. Claim 1 of the present invention is essentially claims 1, 13, 34, 48, 91, 92, 106, 120 and 134 of copending Application No. 10/179651. Claim 1 of the present invention contains many of the same limitations and is of a broader scope than claims 1, 13, 34, 48, 91, 92, 106, 120 and 134 of copending Application No. 10/179651.

Conclusion

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art and its pertinence are as follows.

33. Kroenke (US Patent 5,819,086) discloses a computer system for creating a semantic object model from an existing relational database system where the objects have semantic attributes and semantic links.

34. Swaminathan et al. (US Patent 6,721,726) discloses a knowledge management tool.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970.

The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML



UYEN LE
PRIMARY EXAMINER